



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hashimoto et al.

Serial No. 09/991,751

Filed: November 26, 2001

Group Art Unit: 2854

Examiner: R. Yan

For: STENCIL PRINTING MACHINE

TRANSMITTAL LETTER

The Commissioner for Patents

Washington, D.C. 20231

Sir:

Submitted herewith for filing in the U.S. Patent and Trademark Office is the following:

- (1) Transmittal Letter;
- (2) Response;
- (3) Japanese Patent Office machine translation of JP 08-090893.

Respectfully submitted,

NATH & ASSOCIATES PLLC

Date: June 22, 2004

NATH & ASSOCIATES PLLC

1030 15th Street, NW-6th Floor

Washington, D.C. 20005

By: 

Gary M. Nath

Registration No. 26,965

Marvin C. Berkowitz

Registration No. 47,421

Derek Richmond

Registration No. 45,771

Customer No. 20529



Attorney Docket No. 24835

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For: **STENCIL PRINTING MACHINE**

RESPONSE

Commissioner for Patents

Washington, D.C. 20231

Sir:

This is in response to the Official Action dated March 24, 2004. The three-month shortened statutory period for response is set to expire June 24, 2004. Accordingly, this response is timely filed within the period for reply.

In view of the following remarks, Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections and allow all claims pending in this application.

Claim Rejections Under 35 U.S.C. §103(a) In View Of The '042 Patent

The Examiner rejected claims 1 – 5, 8 – 13, 17 – 21 and 23 under 35 U.S.C. §103(a) as being unpatentable over JP 08-090893 in view of U.S. Patent No. 5,320,042 to Schwöpfinger (hereinafter referred to as “the Schwöpfinger ‘042 reference”).

Response

Applicants respectfully traverse this rejection because there is no motivation to combine the JP '893 reference with the Schwöpfinger '042 reference.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. *See Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 974.

Independent claims 1 and 17 of the present patent application contain limitations that are not taught by the prior art. Claims 1 and 17 recite a stencil printing machine having a printing section composed of a rotary printing drum with an outer circumferential periphery to which a stencil sheet is mounted and also recite a rotary press member (Claim 1) and upstream and downstream rotary press member (Claim 17). The rotary press member (Claim 1) and downstream rotary press members (Claim 17) are recited as including an outer circumferential periphery formed with micro-convexities and micro-concavities.

The present invention is directed toward a stencil printing machine having a printing section comprising a printing drum and a rotary press member which includes an outer

circumferential periphery formed with micro-convexities and micro-concavities. As can be seen in Figs 3 and 8, and as disclosed in the specification at page 25, the structure of the stencil printing machine of the present invention is such that the surface of the printing drum and the rotary press member each directly touch corresponding surfaces of the print sheet. Because of the micro-convexities and micro-concavities on the surface of the rotary press member a contact area with the yet un-fixed ink is minimized thereby avoiding adherence of the ink onto the rotary press drum member.

The Examiner asserts that the JP '893 reference teaches the detailed structure of a screen printing apparatus including a first printing section having a printing drum and a press drum and a downstream printing section having a screen printing drum and a press drum. However, JP '893 teaches at paragraphs [0050] – [0052], a pressure drum 29 with absorption sheet 38 wrapped around it. Pressure drum 29 is rotated in synchronization with drum 31 such that the absorption sheet is pressed into contact with the print sheet that is pressed between the drums 31 and 29. The absorption sheet absorbs excess ink from the print sheet. After each rotational cycle of drum 29, the sheet 38 is discarded and replaced by a new absorption sheet. Applicants submit that in order for the device of JP '893 to function the absorption sheet 38 must have full contact with the print sheet. (Submitted herewith for the examiner's reference is a Japanese Patent Office machine translation of JP '893.)

The Examiner asserts that it would be obvious to provide the second press drum surface of the '893 patent with the micro-convexities and micro-concavities as taught by Schwöpfinger in order to keep the press drum surface from being smeared by freshly printed ink on the print medium.

Applicants respectfully disagree and submit that applying micro-concavities and micro-convexities to the surface of the pressure drum 29 would change the principle of operation

of the JP'893 reference and would thereby render JP'893 unsatisfactory for its intended purpose. The absorption sheet 38 of JP'893 would be rendered ineffective because the addition of micro-convexities and concavities would minimize surface contact with the print sheet and thereby the absorption sheet would not be able to properly remove all of the ink from the surface of the print sheet passed between the drums 29 and 31. *See In re Gordan*, 733 F.2d 900 (fed. Cir. 1984) (If modifying the prior art renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification); *see also In re Ratti*, 270 F.2d 810, (CCPA 1959) (If the proposed modification or combination changes the principle of operation of the prior art, then the references do not support a *prima facie* showing of obviousness). Accordingly, Applicants submit that the micro-concavities and micro-convexities of the Schwöpfinger '042 reference would render absorption sheet 38 of the JP '893 reference inoperative and, therefore, negate any motivation to combine the JP '893 reference with the Schwöpfinger '042 reference.

As such, Applicants submit that independent claims 1 and 17 are not rendered obvious by the JP '893 reference in combination with the Schwöpfinger '042 reference since the cited combination would be inoperative for its intended purpose. Therefore, claims 1 and 17 are patentable over the cited references.

Also, because dependent claims contain all of the limitations of the independent claims from which they depend, dependent claims 2 – 5, 8 – 13, and 18 – 21, and 23 are patentable over the cited references for at least the same reasons as original independent claim 1 and previously presented claim 17.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections.

Claim Rejections Under 35 U.S.C. §103(a) In Further View Of The '353 Patent

The Examiner rejected claims 14 – 16 under 35 U.S.C. §103(a) as being unpatentable over the JP '893 reference in view of the Schwöpfinger '042 reference in further view of the Aoki '353 reference.

Response

For the same reasons set forth above with respect to the Examiner's rejection of independent claim 1, Applicants respectfully traverse the Examiner's rejection.

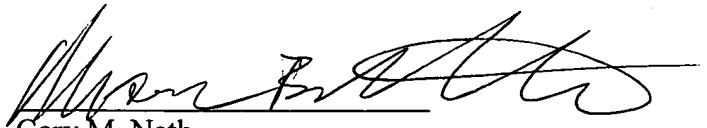
Claims 14 – 16 contain all of the limitations of independent claim 1; therefore, said claims are patentable over the cited references for at least the same reasons as independent claim 1. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections.

CONCLUSION

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejection and allow all pending claims herein. Applicants respectfully request the Examiner to contact the undersigned attorney, if the Examiner thinks it necessary to expedite examination of the present application.

Date: June 22, 2004
NATH & ASSOCIATES PLLC
1030 Fifteenth Street, N.W.
Sixth Floor
Washington, D.C. 20005-1503
Telephone: (202) 775-8383
Facsimile: (202) 775-8396
GMN/MCB/DR

Respectfully submitted,
NATH & ASSOCIATES PLLC


Gary M. Nath
Reg. No. 26,965
Marvin C. Berkowitz
Reg. No. 47,421
Derek Richmond
Registration No. 45,771
Customer No. 20529